

REMARKS

Claims 3, 5-6, 9, 11, 13-14, and 30-40 are currently under consideration in the present application. Claims 2, 4, 7, 8, 10, 12, 15, 16, 18, and 21-29 have been withdrawn from consideration by the Examiner. Claims 3, 5, 6, 9, 11, 13, 14, 17, 19, 20 and 30-34 stand rejected. The claims have been amended herein to obviate informalities and improve their form, and to focus on embodiments of the invention having a single downwardly extending threaded spike, such as the embodiment shown in FIGS. 6, 9 and 10. The Applicants have narrowed the claims currently under consideration to focus on aspects and forms of their invention currently being considered for placement into the marketplace in the near future, without waiving or surrendering any other aspects or forms of their invention. The Applicants expressly reserve the right to continue prosecution at a later date on other aspects and forms of their invention, without prejudice. The amendments made to the claims herein, and new claims 35-40 all find support in the specification and drawings of the application as originally filed. No new matter is added.

CLAIM REJECTIONS UNDER 35 USC § 102

The rejection of claims 3, 5, 6, 9 and 30, as being anticipated by GB 2113993 (GB '993), per paragraphs 1-5 of the Office Action, is traversed.

Independent Claim 3, and claims 5, 6 and 9 depending therefrom, all require, *inter alia*, a lone downwardly extending threaded spike that is adapted to pass completely through the layer of pile and threadably engage the backing of the underlying substrate for securing the apparatus to the underlying substrate as the central base member of the apparatus is rotated to screw the threaded spike through the backing.

GB '993 does not disclose any of these limitations of claim 3, or claims 5, 6, and 9 depending from claim 3, and, therefore, cannot anticipate any of claims 3, 5, 6, or 9.

Claims 5, 6, and 9 also include additional limitations which are not disclosed or taught by GB '993, in combination with the limitations discussed above, and therefore, cannot be anticipated by GB '993.

Claim 30 requires, *inter alia*, a lone downwardly extending threaded spike is adapted for penetrating completely through the pile layer and backing of the carpet and engaging the lower surface of the backing, to thereby fixedly attach the apparatus to the underlying carpet.

GB '993 does not disclose any of these limitations of claim 30, and, therefore, cannot anticipate claim 30.

CLAIM REJECTIONS UNDER 35 USC § 103

The following quotations from a memorandum dated May, 3, 2007 by Margaret A. Focarino, Deputy Commissioner for Patent Operations, and from MPEP § 2143 form the primary basis for traversing all rejections in the Office Action, under 35 U.S.C. § 103(a):

Memorandum from Deputy Commissioner Focarino:

SUBJECT: Supreme Court decision on *KSR Int'l. Co. v. Teleflex, Inc.*

The Supreme Court has issued its opinion in KSR, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/09pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the KSR decision in the near future. Until the guidance is issued, the following points should be noted:

(1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent**

reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

[Emphasis in the original document by Deputy Focarino]

2143 Basic Requirements of a Prima Facie Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

2143.01 Suggestion or Motivation To Modify the References [R-1]

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there

must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The rejection of claims 11, 13, 14, 17, 19, 20 and 31-34, as being unpatentable over GB '993, in view of Carr (US Patent number 1,731,704) per paragraphs 6-19 of the Office Action, is traversed.

The combination suggested by the Examiner does not satisfy all of the limitations of the rejected claims, and would not result in a workable device, and therefore fails to meet two of the requirements for establishing a *prime facie* case of obviousness.

Claims 17, 19 and 20 are cancelled herein, thus rendering moot the Examiner's rejection of those claims.

Claims 11, 13, and 14 all depend from claim 3. Claim 3 requires an apparatus for securing a floor covering to an underlying substrate, such as a carpet or the like, where the underlying substrate includes a layer of pile extending upward from a backing. Claim 3 also requires that the apparatus include a substantially flat and planar central base member adapted to be placed between the floor covering and the underlying substrate. Claim 3 further requires that the central base member have an upper surface thereof adapted for engaging the floor covering, and a lower surface thereof having a lone downwardly extending threaded spike that is adapted to pass completely through the layer of pile and threadably engage the backing of the underlying substrate for securing the apparatus to the underlying substrate as the central base member of the apparatus is rotated to screw the threaded spike through the backing.

As a preliminary matter, the Applicants note that the all of limitations in both the body and preamble of claim 3 are structural limitations, contrary to the Examiner's assertions in the Office Action.

The limitation in the preamble of claim 3, and hence also in claims 11, 13 and 14, to "an apparatus for securing a floor covering to an underlying substrate, such as a carpet or the like, where the underlying substrate includes a layer of pile extending upward from a backing" breathes life and meaning into the claim, and readily distinguishes claims 3, 11, 13 and 14 from devices such as Carr which teach and suggest only attachment of a snap to a floor, and make no teaching or suggestion of attaching two floor coverings together, as required by all claims under consideration in the present application.

The limitations in the bodies of claims 3, 11, 13 and 14 requiring "that the apparatus include a substantially flat and planar central base member adapted to be placed between the floor covering and the underlying substrate," and "that the central base member have an upper surface thereof adapted for engaging the floor covering, and a lower surface thereof having a lone downwardly extending threaded spike that is adapted to pass completely through the layer of pile and threadably engage the backing of the underlying substrate for securing the apparatus to the underlying substrate as the central base member of the apparatus is rotated to screw the threaded spike through the backing," [emphasis added] are all structural limitations. These requirements of claim 3, and claims 11, 13 and 14 depending from claim 3, structurally limit the construction of the apparatus, with regard to the length and configuration of the threaded spike, for example, and the manner in which the threaded spike is connected to the central base member. These structural limitations are not taught or suggested by GB '993 or Carr individually or in combination.

As admitted by the Examiner in paragraphs 9, 11 and 12 of the Office Action the GB '993 reference does not teach or suggest a flat planar central base member having a lower surface of the base member including a lone downwardly extending threaded spike that is adapted to pass completely through the layer of pile and threadably engage the backing of the underlying substrate for securing the apparatus to the underlying substrate as the central base member of the apparatus is rotated to screw the threaded spike through the backing. GB '993 contains no teaching or suggestion of the suitability of any one of its multiple spikes being in any way adapted for penetrating completely through the layer of pile and backing and engaging the backing in such a manner as to secure the floor covering to the underlying substrate in the form of a carpet or the like. And certainly, GB '993 makes no teaching or suggestion of being adapted for attachment by screwing a device according to GB '993 into a carpet.

As further admitted by the Examiner at in paragraphs 9, 11, 12 and 13 of the Office Action, Carr is a two piece arrangement having a conventional screw securing a snap fastener to a floor by passing the screw through the snap and screwing the screw into the floor. There is no teaching or suggestion in Carr that the screw of Carr is in any way

capable of securing the arrangement of Carr to a floor covering such as a carpet of the like lying on a floor through engagement of the backing of the floor covering as is required by claim 3, and by claims 11, 13 and 14 depending from claim 3.

Claim 30, and claims 31-34 depending therefrom, all require an apparatus for securing a rug to an underlying carpet having a pile layer extending upward from a backing defining a lower surface thereof. The apparatus must include a substantially flat and planar central base member adapted to be placed between the rug and the underlying carpet. The central base member must have an upper surface thereof adapted for engaging the rug, and a lone downwardly extending threaded spike adapted for penetrating completely through the pile layer and backing of the carpet and engaging the lower surface of the backing, to thereby fixedly attach the apparatus to the underlying carpet.

As discussed above, with regard to traversal of the rejections of claims 11, 13 and 14, the combination of GB '993 and Carr does not teach or suggest all of these limitations and cannot, therefore, render obvious any of claims 31-34.

With particular regard to the rejection of claims 33 and 34, in paragraph 13 of the Office Action the Examiner has failed to supply specific reasons and structural relationships, in accordance with the recent *KSR* decision and the *Memorandum* by Commissioner Focarino, to explain how structural aspects of Carr would "inherently" meet the claim limitations of the present invention that the central base member of an apparatus according to the invention includes one or more torque receiving or grasping elements. If, as asserted by the Examiner in paragraph 12 of the Office Action, the element (B) of Carr constitutes a "central base member" in accordance with the invention, there is no teaching or suggestion in Carr of the use of element (B) for screwing the screw of Carr into the floor. It would appear that the Examiner is improperly extrapolating or reading in inherency to Carr far beyond its teachings.

The Applicants further respectfully note that GB '993 teaches away from the use of a device, such as Carr, which is attached to the floor, and which does not grip the pile of the carpet on which a matt is being secured. *See GB '993, page 1, lines 21-44.*

In re Appln. Of: Horst et al.
Application No.: 10/803,308

CONCLUSION

The Applicants believe that the application is in condition for allowance, and for the reasons stated above, also believes that the Examiner has not provided a proper basis for rejection of the pending claims. Reconsideration and notification of allowance are respectfully requested. Given the incomplete nature of the Office Action, the Applicants further believe that, in the event the Examiner should wish to maintain a rejection on the basis of GB '993 and Carr, that any subsequent rejection on the basis of GB '993 and Carr should be non-final.

EXAMINER TELEPHONE CONFERENCE REQUESTED

If, after reviewing the above amendments and remarks, the Examiner does not believe the claims to be allowable, the Applicants request that the Examiner contact the undersigned Attorney for the Applicants, prior to issuing either an Advisory Action or another Office Action, to arrange for a telephone conference.

PROCEDURAL MATTERS AND FEES

The Commissioner is hereby authorized to charge the fee for a two month extension of time for filing a reply to this Office Action to deposit account 50-3505. The Applicants believe that no other fees are occasioned by the submittal of this paper. If any fees are occasioned by the filing of this paper, however, the Commissioner is authorized to charge those fees, or credit any overpayments to deposit account 50-3505.

Respectfully submitted,

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